

REMARKS

The Restriction

Applicants respectfully disagree with the restriction. The Patent Office has not established that it would pose a serious burden on the Examiner to search all the groups. No further, or only a minimal, search would be necessary to allow the remaining groups once the elected claims are allowed.

For example, claims 19 and 20 are directed to products comprising the print product of the elected group. Thus if the elected print products themselves are patentable, products comprising the same print products should be patentable as well.

Furthermore, the articles of product claims 19 and 20 are combinations of the print products of the elected claims and other components. As such, it is respectfully submitted that the print products of the elected claims and the combination of said print products and other components are related as combination-subcombination. Since they are related as combination-subcombination, the standard for requiring restriction herein is not met.

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e. separate classification, status, or field of search. See MPEP §808.02. If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

(Emphasis added.) (M.P.E.P. §806.05(c))

It is submitted that the first requirement for two-way distinctness is not established herein. The combination does require the particulars of the subcombination. The products of claims 19 and 20 all require the exact same print products of the same scope as the subcombination claims of the elected group. To this end, the combination claims are even dependent upon the subcombination-product claims and the subcombination-products are an essential distinguishing feature of the combination-products.

It is respectfully submitted that the relationship between the claimed subject matter is not properly characterized, and that, when properly characterized, does not provide a basis for

restriction herein.

Regarding process claims 15-18, applicants bring the attention of the Examiner to MPEP § 821.04, Rejoinder, which states that “if the elected invention is directed to the product and the claims directed to the product are subsequently found patentable, process claims [both process of making and using] which either depend from or include all the limitations of the allowable product will be rejoined.” If the restriction requirement is maintained at this point, rejoinder of the non-elected claims is respectfully requested at the proper time in accord with the rejoinder provisions of the MPEP.

Reconsideration is respectfully requested.

Please note that claim 15 in the Office Action is not identified as withdrawn, which appears to be a clerical error. In order to not have this reply returned as not compliant, applicants followed the Office Action’s designation when providing claim status identifiers for the claims.

The Rejections Under 35 USC § 102 and 103

Claims 1-3, 5 and 12 are rejected as allegedly anticipated by Wang and claims 4, 6-11, 13, 14 and 21 are rejected as allegedly unpatentable over Wang.

Applicants respectfully disagree with the Office Action’s unjustifiably broad interpretation of the term “aligned” to include the opposite of what the term “aligned” means, i.e., having particles “some at one angle and others at another.” Applicants also disagree with the making of the Office Action final as a result of said broad unjustified interpretation immediately as a next action after the filing of an RCE.

The USPTO gives “each term in the claim its **broadest reasonable** construction consistent with the specification.” (Emphasis added.) See *Cargill Inc. v. Canbra Foods Ltd.*, 81 USPQ2d 1705 (Fed. Cir. 2007). It is not a reasonable interpretation of a term at all to include the opposite of what it means.

The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2006 by Houghton Mifflin Company, defines the terms “align” “aligned” “aligning” and “aligns” as follows:

1. To **arrange in a line or so as to be parallel**: align the tops of a row of pictures; aligned the car with the curb.
2. To adjust (parts of a mechanism, for example) to produce a proper relationship or orientation: aligning the wheels of a truck.

3. To ally (oneself, for example) with one side of an argument or cause: aligned themselves with the free traders.
(Emphasis added.)

Even under the broadest reasonable standard, one of ordinary skill in the art would not understand this term to include the embodiments of Wang having particles that are oriented at two or more different angles, i.e., particles which are not aligned.

All evidence of record indicates that the term “aligned” does not mean alignment in various different angles. It is not adequate for the USPTO to merely allege that the “particles of Wang are, in fact, aligned; some at one angle and others at another.” “The examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” See *In re Soni*, 34 USPQ2d 1684 (Fed. Cir. 1995). The Patent Office has not met its initial burden. No evidence of the term “aligned” meaning its opposite has been presented. Mere allegations are made as to the meaning of the term without any support.

Because under the proper construction of the term “aligned,” the application could not have been finally rejected on the grounds and art of record when filing the RCE, the making of the action final is improper. As such, the finality of the last Office Action should be withdrawn and is requested. (If granted, the RCE filed herewith should be considered null and void, and the RCE fee should be refunded.)

Wang teaches “platey” material in the transparent or translucent layer which is “substantially oriented at two or more different angles with respect to the surface of the layer to provide an enhanced three dimensional effect to the decorative surface covering.” See column 2, lines 29-32. The method of forming the decorative surface of the reference includes “reorienting the platey material within the transparent or translucent layer at two or more different angles with respect to the surface of the layer to provide an enhanced three dimensional effect to the decorative surface covering.” See column 2, lines 36-40. Thus, Wang teaches away from the claimed invention.

Nevertheless, to even further advance the application toward allowance, the claims are amended.

Wang teaches surface coverings having platey material. The platey material is taught to have a thickness “of about 0.06 microns to about 0.09 microns.” In contrast, the claimed invention uses platelet-shaped particles having a thickness of 0.1 to 2 μm . Wang teaches to use thinner particles.

It was surprising that thicker particles according to the claimed invention can solve the problem of sinking of primer layers into ink layers during printing. See specification's page 5, last paragraph.

Moreover, the claimed offset print products with specific ordered layer combination and particles of specific thicknesses cannot be compared with the surface coverings of Wang. Wang discloses decorative coating layers which provide a three dimensional effect to the articles covered by such layers. Nothing in Wang teaches or suggests a product which is effective to prevent the sinking of primer layers into ink layers. Wang provides the three dimensional effect by a "platey" material comprised in a transparent layer, which "platey" material is oriented in two or more different angles. Such orientation is produced by disturbing the normal horizontal alignment of the particles in decorative coatings (column 1, lines 30-44), i.e. by directing a plurality of jet streams to the surface (column 7, lines 40-54). It is essential for Wang's teachings that the horizontal alignment of the particles is disturbed and that at least a portion of the "platey" material is vertically oriented with respect to the surface of the layer.

In sharp contrast, the present invention concerns a primer layer in offset printing products comprising platelet-shaped particles, where no such disturbing of the normal horizontal alignment has been effected. To the contrary, such rearrangement would counter the effect of the present invention. Wang does not give any hint in view of the special problems which arise during offset printing concerning contact between image layer and primer layer. Therefore, the teaching of Wang contradicts the teaching of the present invention.

Reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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